

REMARKS

In the Office Action mailed July 11, 2008 from the United States Patent and Trademark Office, claims 1 and 11 were objected to, claims 1-13 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,804,787, and claims 1-13 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending U.S. Application No. 11/057,097. Claims 15-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0097451 to Bjorksten et al. (hereinafter “Bjorksten”), claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,028,049 to Shelton (hereinafter “Shelton”) in view of U.S. Patent Application Publication No. 2004/0139025 to Coleman (hereinafter “Coleman”), claims 7-10 and 12-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shelton in view of U.S. Patent Application Publication No. 2002/0013519 to Adams et al. (hereinafter “Adams”), and claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Shelton in view of Adams and Bjorksten.

Applicant therefore respectfully provides the following:

Claim Objections:

In the Office Action, claims 1 and 11 were objected to. Applicant has amended claim 1 as requested and requests removal of the objection.

Regarding the objection to claim 11, the objection is to the phrase “said commentary” for lack of antecedent basis. Claim 11 depends on claim 7, which recites “accepting commentary on the accuracy of said information...” at line 6 (emphasis added). Therefore, Applicant

respectfully submits that there is antecedent basis for the language objected to, and therefore requests removal of the objection to claim 11.

Double Patenting Rejections:

In the Office Action, claims 1-13 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,804,787, and were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of copending U.S. Patent Application No. 11/057,097. The Office Action also indicated that the prior office action provided an analysis of the claims to support the rejection and that as the language of the patent is more specific than the claims of the instant application the claims are not patentably distinct.

M.P.E.P. § 804(II)(B)(2): (REQUIREMENTS OF A DOUBLE PATENTING REJECTION: Nonstatutory Double Patenting: Obviousness Type) sets forth that:

[T]he analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent.

(Emphasis added.)

Applicant respectfully submits that the rejections set forth in the Office Action have failed to satisfy the requirements set forth above. Note that breadth or specificity is not recited as part of the above analysis. Specifically, the Office Action recites that the instant claims 1-13 correspond to claims 1-19 of U.S. Patent No. 6,804,787. The only comparison between any of the instant or cited claims is set forth in the office action at page 9 with the phrases “the instant application generally claims...” and “see claim 1” (directed to claim 1 of the instant application and the cited patent. The comparison set forth in the Office Action does not analyze and “make clear” (as is required by M.P.E.P. § 804 as recited above) what the differences are between the claims other than to recite words or phrases taken from the respective claims taken completely out of context of the claims themselves.

As the only apparent comparison provided in the Office Action is between claim 1 of each of the instant application and the patent, Applicant provides below a side-by-side comparison between independent claim 1 of the instant application and independent claim 1 of the cited patent. Both compared claims are method claims.

Instant Application:

1. A method for controlling a release of personal information comprising:

depositing some personal information regarding an individual with a server;

obligating organizations that possess additional personal information regarding said individual to not disclose that additional personal information without authorization from said server; and

instructing said server to not release said some personal information held on the server and to not authorize release of said additional personal information at the obligated organizations without receiving authorization from said individual.

Patent 6,804,787

1. In a system that includes a computer device, a method for managing healthcare data in compliance with regulated privacy, security, and electronic transaction standards, the method comprising:

receiving from a requestor a request for healthcare information relating to a patient, wherein any request is received through a single point of entry regardless of whether the request is from a requestor internal or external to a given healthcare facility;

retrieving the requested healthcare information;

assembling a report, wherein the report includes:

the requested healthcare information;

any comments of the patient received at a gatekeeper system regarding the requested healthcare information; and

an audit trail; and

transmitting a copy of the report to the requestor through a single point of exit regardless of whether the request was from a requestor internal or external to the given healthcare facility.

As may be seen from the above side-by-side comparison, there are significant differences between the claims that the Office Action indicates are obvious variants of one another.

Applicant respectfully submits that the differences are patentable, and that the Office has not satisfied its burden of showing that one of skill in the art would have found the claims at issue to be anticipated by or an obvious variant of claim 1 of the cited patent.

Specifically, the instant claim 1 requires “obligating organizations that possess additional personal information regarding said individual to not disclose that additional personal

information without authorization from said server.” Referring to claim 1 of the cited patent, as set forth above, there is no corresponding limitation set forth. Indeed, the cited patent specifically sets forth that all requests are handled through a single point of entry/exit, which shows that the patented invention is handled in its entirety within a single organization, not by obligating other organizations as is recited in the application’s claim 1.

Applicant again notes that the double patenting rejections in both the prior and current office actions have been made without any recitation of claim language except 1) an indication that the instant application “generally claims a method for controlling a release of personal information,” and 2) a list of individual words from claim 1: “personal information,” “organizations,” “individual,” “enterprise/server,” and “to not release information . . . without receiving authorization from said individual.” (See Office Action at paragraphs 12-13.)

Applicant respectfully notes that the mere listing of extracted words from claim 1 of the instant application fails to convey or in any way examine the actual meaning of the method claim. By way of illustration, claim 1 is provided below with the recited claim language underlined:

1. A method for controlling a release of personal information comprising:
depositing some personal information regarding an individual with a server;
obligating organizations that possess additional personal information regarding
said individual to not disclose that additional personal information without
authorization from said server; and
instructing said server to not release said some personal information held on the
server and to not authorize release of said additional personal information
at the obligated organizations without receiving authorization from said
individual.

It is worth noting that in this method claim, not one of the gerunds beginning the various limitations of the claim (depositing, obligating, or instructing) has been recited in the Office Action. Therefore, regardless of whether there are some correlating words in the claims of Patent No. 6,804,787 to the underlined words of claim 1 listed above and in the Office Action,

Applicant respectfully submits that the rejection set forth in the Office Action grossly fails to demonstrate that claim 1 of the instant application is not patentably distinct from the claims of the patent. The rejection of the claims provided in the Office Action does not include an analysis of the claims to support the rejection, but only provides an analysis of a few selected similar words from the claim without any analysis as to claim meaning. No analysis of dependent claims 2-6 was provided in the Office Action. Therefore, a similar deficiency is present as to the rejections of those claims.

Furthermore, regarding claim 7 (and dependent claims 8-13), Applicant respectfully notes that the analysis provided in the Office Action is even farther from what is recited in the claim, and that the Office Action completely fails to analyze the limitations of claim 7. By way of illustration, claim 7 is provided below with the terms discussed in the Office Action underlined in the claim language:

7. A method for creating a database of verified personal information comprising:
gathering information regarding an individual;
presenting said information over a wide area computer network to said individual
to review and verify said information's accuracy;
accepting commentary on the accuracy of said information based on said review
from said individual over the wide area computer network;
including said commentary in said database with said information;
receiving a request over said wide area computer network from an authorized
individual to review selected portions of said information;
presenting said request to said individual for authorization;
presenting said selected portions of said information over said wide area computer
network to said authorized individual; and
providing access to said database and said commentary to third parties.

As may be seen from the claim, the claim completely fails to correlate with the rejection set forth in the Office Action. Additionally, Applicant again notes that not a single gerund of this method claim (gathering, presenting, accepting, including, receiving, presenting, or providing) has been

discussed in the Office Action. Therefore, the rejections of claims 7-13 cannot stand and should be removed.

Regarding the provisional double patenting rejections over claims 1-24 of copending U.S. Patent Application No. 11/057,097, Applicant also notes that similar problems are present for the rejection. Specifically, the only supposed claim language discussed in the rejections is a single phrase: “if the requested information is not subject to the requirement, releasing the requested information to the requestor.” (See Office Action at paragraph 20.) Applicant respectfully notes that the recited language is simply not a part of any of the claims and never has been. Both quoted passages are from the copending application, and no analysis whatsoever of the instant application is set forth.

Therefore, the rejections cannot stand and must be removed.

Applicant believes the comments submitted in the Response dated October 24, 2007 regarding the double patenting rejections are entirely relevant and clearly show that the claims of the instant application are patentably distinct. Rather than completely restate those arguments, Applicant refers the Examiner to those comments, which are explicitly incorporated by reference. Those arguments are provided on pages 10-16 of the October 24, 2007 Response. Applicant notes that the *Graham* inquiries necessary for a proper double patenting rejection require specific factual findings by the Patent Office regarding the scope and content of the prior art claims and the differences between the prior art claims and the claims of the instant application. (See M.P.E.P. §§ 2141 & 2142. See also, for example, the enumerated required articulations set forth in M.P.E.P. § 2143 for each lettered rationale.)

Applicant therefore respectfully requests removal of all double patenting and provisional double patenting rejections.

Rejections under 35 U.S.C. § 102(e):

In the Office Action, claims 15-20 were rejected under 35 U.S.C. § 102(e) as being anticipated by Bjorksten. Additionally, the Office Action indicated that Applicant's prior arguments with respect to the rejections were not persuasive. Applicant strongly disagrees with the position taken in the Office Action, but has nevertheless amended the claims to more clearly distinguish over Bjorksten. It is noted that no disclosure is made in Bjorksten that the automatic information collector collects any information from anyone other than the individual. Therefore, Applicant's prior comments, which are repeated below, show that the claims are not anticipated by Bjorksten.

M.P.E.P. § 2131 sets forth the standard for a rejection of a claim as anticipated under 35 U.S.C. § 102. "To anticipate a claim, the reference must teach every element of the claim."

M.P.E.P. § 2131 states further,

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). . . . "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant respectfully submits that Bjorksten fails to teach every element of the claim set as provided herein for at least the following reasons.

Independent claim 15 is a method claim that requires: "automatically gathering information regarding an individual from a plurality of information sources not controlled by the individual over a wide area computer network." Bjorksten fails to teach automatically gathering

information regarding an individual from a plurality of information sources. Instead, Bjorksten teaches the use of an automatic information collector for capturing personal information about a user. (Para 0046) Bjorksten teaches how the automatic information collector gathers information about the user at Figure 15 and paragraphs 0116-0118. This teaches that the automatic information collector monitors the user's interactions with websites and collects the information based on the user's requests and the user's responses to requests for information. (Para 0117) Therefore, the automatic information collector of Bjorksten does not gather information from a plurality of information sources not controlled by the individual, but only gathers information from the user as the user interacts with websites. Therefore, Bjorksten does not teach this limitation of claim 15.

Claim 15 also requires "presenting said information and the sources of said information over the wide area computer network to said individual to review and verify said information's accuracy." Bjorksten fails to teach presenting the sources of information to the individual for review, as in Bjorksten all information comes from the user (see above). The Office Action cites paragraphs 0040-0041 regarding presenting information to the user. This portion does not teach presenting sources of information to the individual, but merely teaches user creation, editing, and controlling the sharing of a master profile of the user's information. Releasing information to others (as cited by the Office Action at page 4, end of the first paragraph) is simply not the same as presenting the individual with the source of the information regarding the individual. Therefore, Bjorksten does not teach this limitation of claim 15.

Claim 15 further requires: "accepting commentary on the accuracy of said information based on said review from said individual over the wide area computer network" and "including said commentary in said database with said information." These limitations are not taught by

Bjorksten. Bjorksten teaches that the user may edit/change the profile, but does not teach the acceptance of any commentary on the accuracy of information or the inclusion of such commentary with the information. Therefore, Bjorksten does not teach these limitations of claim 15 as set forth in the claim. This limitation can be important in the information management world, as if the user is merely allowed to change information about the user, the user is able to change information to fraudulent information. The claimed invention, on the other hand, maintains the original information as well as the individual's commentary on the accuracy of the information, so that someone viewing the information sees all available information and commentary thereon, and can make his or her own judgments about what information is accurate (see next paragraph).

Claim 15 also recites: "presenting said selected portions of said information over said wide area computer network to said authorized individual along with identification of said sources of said selected portions of said information and any commentary on the accuracy of said selected portions of said information provided by said individual" and "providing access to said database and said commentary to third parties." Such limitations are not taught by Bjorksten, as Bjorksten fails to teach storing of any commentary of identification of sources of information (see above) and therefore also fails to teach presenting these or providing access to these features to others.

Therefore, for at least the foregoing reasons, Applicant respectfully submits that Bjorksten fails to teach all elements of claim 15. Claims 16-20 depend on claim 15, and are therefore allowable for at least the same reasons. Applicant therefore respectfully requests removal of all rejections under 35 U.S.C. § 102(e).

Rejections under 35 U.S.C. § 103(a):

In the Office Action, claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shelton in view of Coleman, claims 7-10 and 12-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shelton in view of Adams, and claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Shelton in view of Adams and Bjorksten. Additionally, the Office Action indicated that Applicant's prior arguments were not persuasive with respect to the prior rejections.

Applicant has amended the claims to more clearly define over the cited references. As the limitations added to the claims have been drawn from rejected claim 11, Applicant addresses the rejection of claim 11 in more detail below.

M.P.E.P. § 2141 sets forth the *Graham* factual enquiries that should be considered when making an obviousness rejection under Section 103: 1) ascertaining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) In addition, M.P.E.P. §§ 2141 and 2142 set forth that "the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." (Citing *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007).)

Therefore, for a rejection under Section 103 to stand, it must explicitly set forth 1) factual findings showing that each claim element was known in the art at the time of the invention, and 2) factual findings showing that one of ordinary skill in the art, at the time of the invention, would have found it obvious to modify or combine the teachings to arrive at the claimed invention. (See, for example, the enumerated required articulations set forth in M.P.E.P. § 2143 for each lettered rationale.) Applicant respectfully submits that the references cited by the

Examiner, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. Therefore, Applicant respectfully submits that the differences between the cited references and the claimed invention show that the claimed invention is not made obvious by the cited references.

All rejected claims now recite accepting commentary on the accuracy of information based on review from said individual, wherein the commentary includes explanations of incorrect information on said server, as was previously recited in claim 11. Applicant notes that the corresponding language from claim 11 was rejected in view of Bjorksten. Applicant respectfully notes that the Office Action indicates that such language is not taught by the other cited references. Therefore, if Bjorksten does not teach such language, then the references in combination do not teach such language. Applicant respectfully submits that Bjorksten does not teach such limiting language.

It should be noted that the rejected language requires “explanations of incorrect information,” not just corrected information. As has been discussed above, the mere allowance of correction of information has a different value to the user of the information than providing the original information with explanations of incorrect information as is claimed. Bjorksten teaches the former, but does not teach the latter.

As a hypothetical example, suppose a potential healthcare insurer wishes to view health information as part of deciding whether to offer insurance to the individual. Further suppose that the individual had been a victim of identity theft, whereby the thief obtained cancer treatment in the name of the individual. As is commonly known, it is extremely difficult to expunge such information from a person’s healthcare records. Now, take what is taught by Bjorksten in

paragraphs 0039-0042 – according to that teaching, the patient would merely change the record to reflect that no treatment for cancer had ever happened. In this case, the healthcare insurer does not see that such treatment happened, and would be more likely to offer insurance.

But in this instance, how is the healthcare insurer to know whether the change reflects the truth or not? The only information presented to the healthcare insurer is that no such treatment was ever given to the individual. What if, instead of the user being a victim of identity theft, the user truly had been treated for cancer and wanted to cover it up to obtain insurance? In this instance, the change could defraud the potential insurer.

The claimed invention, on the other hand, prevents such occurrences and provides definite advantages to information users. According to the claimed invention, the insurer would now be presented with the original information (treatment for cancer) along with the user's explanation of incorrect information ("That treatment was not for me but was provided to someone who stole my identity."). Now the healthcare provider is placed on notice of an information dispute and can investigate further to discover the truth.

Therefore, Applicant respectfully submits that Bjorksten's teaching of allowing the user to edit his or her information does not teach or suggest the limitations required by claims 1-10 or 12-13, and respectfully requests removal of the rejections.

CONCLUSION

Applicant submits that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 11th day of December, 2008.

Respectfully submitted,

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